

IV. REMARKS

In the Office Action dated 23 June 2009, in the above-referenced patent application, please enter the amendment and reconsider the application. It is believed that no new matter has been added.

In paragraphs 1-2 of the Office Action, the Examiner has graciously noted that the action is in response to the application filed 7 October 2003, that claims 1-26 are currently pending. Applicant notes that the instant application claims priority from, and incorporates by reference, U.S. Patent Application Ser. No. 60/416,264 filed October 7, 2002.

In paragraphs 3-4 of the Office Action, the Examiner has rejected claims 1-26 pursuant to 35 U.S.C. Sec. 101 for reasons more precisely stated in the Office Action.

In response the rejection is respectfully traversed as improper for failing to make out a case of prima facie unpatentability. The rejection appears to be based on the PTO's interpretation of *Bilski*, which the U.S. Supreme Court is reviewing on appeal. The law is in doubt, and so is the rejection, which is traversed as improper for the reasons set forth in the appeal deemed reviewable by the U.S. Supreme Court. However, in view of the Federal Circuit decisions in *Paymentech* and *MuniAuctions*, Applicant is amending the claims to apparatus form, and therefore the rejection is moot. The new claim 27 is a linking claim.

In paragraphs 5-9 of the Office Action, the Examiner has rejected claims 1-26 pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, based on contentions more precisely set out in the Office Action. The Examiner contends that Shariah refers to a source of laws, and not the laws themselves" (page 3) and relies on *Ex parte Simpson*.

In response the rejection is respectfully traversed. The Examiner has not set out

a prima facie case of unpatentability under Sec. 112, and there appears to be some confusion in the rejection. Pursuant to 35 U.S.C. Sec. 132 and Rule 104, Applicant is entitled to *information* as set forth below.

First, the Examiner states at page 3 of the Office Action, with regard to Shariah in the claims, that “The name is used to identify a source of laws, and not the laws themselves” but elsewhere on page 3 of the Office Action, the Examiner states: “Claims 1, 11, and 12 contain the name “Shariah” for the body of Islamic religious law.” The Examiner also states, at page 5 of the Office Action, that “Shariah compliance is an old and well known body of Islamic law”. Applicant agrees with the Examiner that the Shariah is a body of Islamic law. This is consistent with the Oxford English Dictionary definition of “Shariah” as “Islamic canonical law...” (see enclosed) and see also the enclosed decision of the Shariah Appellate Bench of the Supreme Court of Pakistan).

Second, as regards the Examiner’s reliance on *Ex parte Simpson* at page 3 of the Office Action, the decision appears to relate to the use of a trademark in a claim; Applicant’s claims do not contain a trademark. The Examiner states on page 3 of the Office Action: “Where the name ‘Shariah’ is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. Sec. 112, second paragraph.” However, Applicant’s claims do not use “the name Shariah” “in a claim as a limitation to identify or describe a particular material or product.” As set forth above, Applicant instead agrees with the Examiner’s statements concerning the Shariah being a body of Islamic law, as set out in Applicant’s specification at page 56 “Islamic law (also known as Shariah.)”.

Claim 7 has been rejected pursuant been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that facilitate is a relative term which renders the claim indefinite and that the term is not defined by the claim and that the specification does not

provide a standard for ascertaining the requisite degree.

In response, the rejection is respectfully traversed. The Oxford English Dictionary, for example, defines “facilitate” as “make easier.” The plain and ordinary meaning of the word is clear, and the Office Action does no more than assert to the contrary – there is no showing or evidence that a skilled artisan would have any difficulty in ascertaining its meaning or scope. In sum, the Office Action fails to make out a case of prima facie unpatentability based on Sec. 112. However, the rejection is made moot by the above-provided amendment, made in connection with having the claims be directed to the apparatus class of patentable subject matter.

Claims 11 and 12 have been rejected pursuant been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that standard is a relative term which renders the claim indefinite and that the term is not defined by the claim and that the specification does not provide a standard for ascertaining the requisite degree. In response, the rejection is respectfully traversed, but again the rejection is moot in view of the above-provided amendment, made in connection with having claims be directed to the apparatus class of patentable subject matter.

Likewise, claims 15 and 18 have been rejected pursuant been rejected pursuant to 35 U.S.C. Sec. 112, second paragraph. The Examiner contends that ensure servicing in claim 15 and service in claim 18 are relative terms which render the claims indefinite and that the terms are not defined by the claims and that the specification does not provide a standard for ascertaining the requisite degree. In response, the rejection is respectfully traversed, but again the rejection is moot in view of the above-provided amendment, made in connection with having claims be directed to the apparatus class of patentable subject matter.

In paragraph 10 of the Office Action, the Examiner has provided a copy of Sec.

35 U.S.C. Sec. 102, and in Paragraph 11 of the Office Action, the Examiner has rejected claims 1-26 pursuant to 35 U.S.C. Sec. 103 for reasons more precisely stated in the Office Action.

In response the rejection is respectfully traversed as improper for failing to make out a case of prima facie unpatentability. More particularly, the Examiner relies on Gould, concedes at page 5 that “Gould does not disclose *Shariah compliant*”, and according to the Examiner: “it would have been obvious to one of ordinary skill in the art to modify Gould to provide a *Shariah compliant* credit enhancement because Shariah compliance is old...”

First, the rejection is improper because the applied art fails to disclose expressly claimed elements or limitations: there is no teaching whatsoever of a Shariah compliant credit enhancement, and but for Applicant’s claimed invention, there would be no disclosure or suggestion whatsoever as to how one might do a Shariah compliant credit enhancement. Nothing in the Shariah or in Gould mentions anything about a Shariah compliant credit enhancement.

Second, as set out more precisely in the enclosed paper by Mufti Taqi Usmani titled “*The Historic Judgment on Interest*,” a 14 Ramadan 1420 decision of the Shariah Appellate Bench of the Supreme Court of Pakistan bans interest in all its forms and by whatever name it may be called. Gould is replete with explicit teachings of “allocating mortgage interest”. See, e.g., the technical field of the Gould invention. Thus, the contention that it would be obvious to combine or modify the cited art to reach the claimed invention is hopelessly contradictory and improper. More so, it is the Examiner’s burden to show that the rejection would not be contradictory and improper.

As a background, pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to “the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*”. A similar requirement is made by Rule 104(a)(2), which

requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Otherwise, the rejection is improper.

Generally, Applicant has been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth. In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*".

Further, generally, the Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2D 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met.

Pursuant to 35 U.S.C. Sec. 132 and Rule 104, in view of the aforesaid burden, the Examiner is required to provide *information* as to how Gould could be modified to reach Applicant's claims (e.g., be Shariah compliant), e.g., in view of the Decision of the Shariah Appellate Bench of the Supreme Court of Pakistan bans interest in all its forms and by whatever name it may be called. Applicant submits that the evidence, including the Decision in view of Gould, establishes that:

- (1) the contended combination of teachings to reach the claimed invention would change the principles of operation of the respective cited art;
- (2) there is no motivation or suggestion has been shown in the cited art that, as of the date of the instant application, would have prompted one skilled in the art to make the combination or modification to reach the claimed invention;
- (3) the art teaches away from the claimed invention;

- (4) no reasonable expectation of success has been established for making the proposed modification or combination;
- (5) the contended combination of teachings to reach the claimed invention would render the cited art inoperable for their respective purposes; and
- (6) the rejection fails to consider the expressly claimed rejection as a whole.

Based on the evidence of the Decision, in view of the aforesaid burden to establish unpatentability and the aforesaid requirements to provide *information*, it is for the Examiner to establish otherwise.

(For the convenience of the Examiner in considering the evidence of the Decision, as is required, note that “Riba” corresponds to “interest” and that interest and usury can be viewed as the same. While it is appreciated that the Decision of the Shariah Appellate Bench of the Supreme Court of Pakistan is not controlling precedent over Patent Office operations, Islamic law is not geographically limited and the Decision is evidence of the meaning to one skilled in the art.)

In sum, the applied art fails to disclose expressly claimed elements or limitations: the cited art provides no clue as to how one might make a Shariah compliant credit enhancement, and Applicant is entitled to *information* as set forth above. The Office Action fails to make out a case of prima facie unpatentability in an improper rejection.

Yet further, at pages 10-12, the Examiner takes Official Notice of seemingly all claim requirements for claims 2, 6, and 13-26. This is improper as an attempt to officially notice a fact, which is not in compliance with the PTO's own procedures. See ***Memorandum to Patent Examining Corps from the Deputy Commissioner for Patent Examining Policy***, a *courtesy copy of which is being filed herewith*. Proper use of Official Notice requires compliance with several obligations expressly set forth in the *Manual of Patent Examining*

Procedure. The Office has failed to meet these obligations. Specifically, the Office has failed to satisfy its obligations under MPEP § 2144.03. *MPEP § 2144.03 (B)*, for example, expressly requires the Office to provide specific factual findings predicated on sound technical and scientific reasoning to support taking Official Notice. The *MPEP* goes on to explain that this means that the Office should present an Applicant with the explicit basis on which Official Notice is based so that the Applicant is able to challenge the assertion in the next reply after the Office Action. (*MPEP § 2144.03(B)*). Naked assertions about what is allegedly known in the art, like those made in the Office Action, cannot satisfy these requirements. Applicant respectfully requires establishing the contended facts.

Second, in view of the rejection of claim 1, the Office Action relies on Official Notice as the “principal evidence” upon which the rejection of claims 2, 6, and 13-26 is based. Official Notice cannot be used in this manner. As Section 2144.03(A) of the *MPEP* expressly warns, it is never appropriate to rely solely on Official Notice as the principal evidence upon which a rejection was based. Instead, Official Notice is only appropriate for facts and that serve to “fill in the gaps” in a rejection. (*MPEP § 2144.03(A)*). This is why Official Notice is to be judiciously applied. (*MPEP § 2144.03*). It is unreasonable to conclude that the Office has used Official Notice to “fill in” a gaps in rejecting claims 2, 6, and 13-26 is based solely on Official Notice, in view of the rejection of claim 1.

Third, the rejection attempts to take Official Notice of matter that is not “capable of instant and unquestionable demonstration”, as expressly required by section 2144.03(A) of the *MPEP*. Indeed, even assuming *arguendo* that the various matters set out in pages 10-12 are fact, these facts would be neither of notorious character nor instantly and unquestionably demonstrable, e.g., exist in a manner so as to be Shariah compliant. Moreover, courts have long rejected the notion that official notice can be taken on the state of the art. (*See*

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Examining Policy regarding Procedures for Relying on Facts Which are Not of Record as

Common Sense or for Taking Official Notice, n.6, *citing In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973)). Thus, fourth, the rejection's attempt to Officially Notice the level of ordinary skill in the art is also improper as a matter of law.

Fifth, the aforementioned facts must be presented in a manner that would permit Applicant to make a determination as to whether there is a proper reason to combine or modify, in view of the Shariah compliant element of the claims. In this regard, the Examiner is required to provide *information* explaining how the facts set out as "Official Notice" appear in the prior art so as not to be inconsistent with the Shariah compliant element of the claims. See, e.g., the Decision of the Shariah Appellate Bench of the Supreme Court of Pakistan.

In sum, the Office's attempts at Official Notice are improper and traversed. Consequently, there are evidentiary gaps in the rejections of the claims that are fatal to a *prima facie* case of obviousness. The same applies as to the new claim.

Accordingly, the claims are believed to be in condition for allowance, and favorable action is respectfully requested.

In addition, Applicant requests a personal interview to advance prosecution. Further, as always, the Examiner is invited to contact the undersigned at the telephone number set out below if it can in any way expedite or facilitate issuance of a patent on the application.

III. Conclusion

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefore.

The application is believed to be in condition for allowance, and favorable action is respectfully requested. Please direct all communication to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'PK Trzyna', followed by a horizontal line.

Date: December 23, 2009

Peter K. Trzyna
(Reg. No. 32,601)

P. O. Box 7131
Chicago, Illinois 60680-7131
(312) 240-0824